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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,462	01/28/2002	Rob Neeper	PA04D (111870-0092)	4677
27189	7590	11/03/2005	EXAMINER	
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP			ALEXANDER, LYLE	
530 B STREET			ART UNIT	
SUITE 2100			PAPER NUMBER	
SAN DIEGO, CA 92101			1743	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,462

Applicant(s)

NEEPER ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-42, 44, 45, 49, 53, 54, 56 and 58-64 is/are rejected.
- 7) ☒ Claim(s) 46-48 and 51-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 39-42,44-45,49,53-54,56 and 58-64 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yaremko et al. (USP 5,578,269).

Yaremko et al. teach a method of processing samples using glass beads as a solid support. Samples are automatically loaded into bar coded cuvettes until the centrifuge is full. Heating means is supplied to incubate the sample/reagent if necessary. A computer and associated controller controls this automated process.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 43, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaremko et al. (USP 5,578,269).

Sée Yaremko et al. supra.

Yaremko et al. is silent to the use of vacuum pumps to reduce the pressure in the centrifugation chamber and the speeds of the centrifuge.

The court decided In re Boesch (205 USPQ 215) that optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has predictable and well-known results. The use of a vacuum has the well-known and predictable result of reducing the air molecules in a container and thus reducing the

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resultant drag and amount of power needed to turn the centrifuge. Selection of the speed of rotation of the centrifuge has the well-known and expected result of increasing or decreasing the centrifugal force and sedimentation of the sample.

It would have been within the skill of the art to modify Yaremko et al. and pull a vacuum in the centrifugation chamber to reduce the amount of resistance inside the chamber and lower the power consumption as optimization of a result effective variable. Further, it would have been within the skill of the art to modify Yaremko et al. and use centrifugation speeds of 20-30 and up to 800 rpm as optimization of a result effective variable to gain the well known effects of sedimenting the desired components of the sample.

Allowable Subject Matter

Claims 46-48 and 51-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive.

Applicants' remarks concerning the 35 USC 112 second paragraph issues were convincing.

Applications 10/059,082 and 09/006,629 have both been abandoned obviating the Double Patenting rejections. The remaining Application 10/058,380 now USP

6,808,935 is sufficiently distinct from the instant claims to also obviate the Double Patenting rejection.

Applicants' state the instant claims are directed to a solid support to which compounds are bound. The instant claim language now recites "... samples linked to solid support...". The Office maintains this new language is sufficiently broad to cover sample in the proximity of the support. Applicants' are encourage to claim the type of bond (e.g. covalent, ionic, etc.) intended by the claimed "linking".

Applicants' state the instant invention is an improvement over Yaremko et al. as the process is streamlined. Yaremko et al. teach all of the claimed steps. The instant claims are open and do not exclude any additional steps/process contemplated by Yaremko et al.

Applicants' traverse the 35 USC 103 rejection on the basis the addition of a vacuum pump would not have been an optimization of a result effective variable as stated by the Office. The Office maintains applications of vacuums are notoriously well known in the art for the reasons of record and supplying the means to accomplish the application of a vacuum is inherent in the rejection of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
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